

REMARKS

The specification has been amended to make editorial changes to place the application in condition for allowance at the time of the next Official Action.

Claims 11-23 were previously pending in the application. Claims 11-23 are canceled and replaced with new claims 24-43. The new claims are believed to address the 35 USC §112, second paragraph rejection set forth in the Official Action.

Claims 11-23 are rejected as unpatentable over EBERT 3,028,688 in view of HUNZIKER 3,543,573.

Reconsideration and withdrawal of the rejection are respectfully requested because the references do not disclose or suggest a testing pipe arranged substantially parallel to and vertically above a flow pipe, the flow pipe and the testing pipe being substantially closed to outside ambient as recited in new claim 24 of the present application.

In addition, the references do not teach or suggest first and second connection members arranged at both ends of the flow and testing pipes and interconnecting the flow and testing pipes to permit fluid flow through the flow and testing pipes, the connection members each comprising a stilling basin as further recited in new claim 24 of the present application.

Further, the references do not disclose or suggest a lure tower for testing a lure lowered into the swimming device through an opening in the lure tower, the lure tower extending substantially vertically from the testing pipe and connected thereto.

By way of further explanation, Figure 1 of the present application shows a flow pipe 1 and a testing pipe 2. The testing pipe 2 is arranged substantially parallel to and vertically above the flow pipe 1. The flow pipe 1 and the testing pipe 2 are substantially closed to outside ambient. As seen in Figure 1, the only opening to outside ambient is the opening in lure tower 13.

First and second connection members 3 and 4 are arranged at both ends of the flow and testing pipes and interconnect the flow and testing pipes to permit fluid flow through the flow and testing pipes as seen by the flow arrow in connection member 3. The connection members each comprise a stilling basin 9, 10 as set forth on page 3, lines 10-14 of the present application. Stilling basins 9 and 10 are arranged at each end of the device to control the swirling of the fluid and the fluid in the device is led through the basins as it flows between the flow pipe and the testing pipe.

The lure tower 13 is for dropping a test lure 12 therethrough such that the lure is lowered into the swimming

device into testing pipe 2 through an opening in the lure tower. The lure tower extends substantially vertically from the testing pipe and is connected thereto.

EBERT in Figures 1 and 2, for example, shows top and side views of the device of EBERT. As seen in Figure 1 of EBERT, the device of EBERT is a substantially oval-shaped basin having a divider 15 running longitudinally in the basin to divide the basin. One of ordinary skill in the art would understand that stage area 32 and sluiceway 33 formed when the divider wall 15 is in place are not a flow pipe and a testing pipe. In addition, stage area 32 and sluiceway 33 are in the same horizontal plane. The testing pipe is not above the flow pipe. Turning EBERT on its side would cause the fluid in EBERT to run out since EBERT is an open basin and renders the device of EBERT inoperable.

MPEP §2143.01 states that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1994). Accordingly, EBERT could not be modified such that a testing pipe is arranged substantially parallel to and vertically above the flow pipe as recited in claim 24 of the present application.

In addition, as noted above, the basin of EBERT is open to atmosphere, not substantially closed to outside ambient.

The device of HUNZIKER is a device for testing marine engines. As seen in Figures 5 and 6 of HUNZIKER, for example, a marine engine 62 is lowered into the basin 10. Such a testing apparatus is not substantially closed to outside ambient. In addition, as seen in Figure 2 of HUNZIKER, the flow basin is essentially an oval basin with a baffle 75 in a central part of the basin. One of ordinary skill in the art would not read a flow pipe and a testing pipe arranged substantially parallel to and vertically above the flow pipe on the oval basin and dividing baffle of HUNZIKER.

In addition, as set forth above, the connection members of the present invention as recited in claim 24 each comprise a stilling basin. EBERT and HUNZIKER do not teach or suggest a stilling basin that would control the swirling of fluid in the device as the fluid flows between the flow pipe and the testing pipe. The vertical deflectors 46 of EBERT are disclosed at column 2, lines 55-57 as guiding the water around the divider and HUNZIKER discloses that baffles 75, 76, 77 direct the water in a return circuit at column 3, lines 41-45. Neither reference discloses a stilling basin as recited in claim 24 of the present application that would control the swirling of the fluid.

Further, the Official Action notes that EBERT does not show a lure tower. To overcome this shortcoming, the Official Action attempts to combine HUNZIKER with EBERT and states that

HUNZIKER teaches lure tower 34, 35, 36, 50. These elements define the opening through which the marine engine 62 will be placed. The Official Action states that the purpose for providing this opening would be to prevent water from splashing from the top of the pipe. However, EBERT does not recognize that there is a problem with water splashing from the top of the pipe and in any event, the water of EBERT is flowing in a horizontal plane that would not have a vertical component that would cause splashing.

MPEP §2143.01 states that the mere fact the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Since the basin of EBERT is open, applicant is confused as to why one would close the basin of EBERT and then put an opening as suggested in the Official Action. Further clarification of the motivation to combine references is respectfully requested.

The above-noted features are missing from each of the references, are absent from the combination, and thus are not obvious to one having ordinary skill in the art. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Claims 25-33 depend from claim 24 and further define the invention and are also believed patentable over the cited prior art.

In addition, the dependent claims also include features not disclosed in the combination of references. For example, claim 25 provides that the flow pipe extends beyond the testing pipe and the connection members are flow ports in a wall of the flow pipe. Such a feature is seen in Figure 2 of the present application. Claim 27 provides control lamellas in the flow pipe oriented in a longitudinal direction of the flow pipe. Claim 33 provides that the testing pipe decreases in diameter along a length of the testing pipe in a direction of fluid flow. None of these features are disclosed in the references and thus these claims are believed patentable regardless of the patentability of the claims from which they depend.

New independent claim 34 provides that the testing pipe decreases in diameter along a length of the testing pipe in a direction of fluid flow. As set forth on page 3, lines 30-33, the testing pipe is preferably arranged to narrow in the direction of fluid flow which prevents air bubbles generated by the control means from collecting on the walls of the pipe and allows them to flow to the lure tower and exit the device. Page 4, lines 4-7 of the present application disclose that an accelerating flow rate is achieved in the testing pipe which

narrows toward its other end, whereby the lure being tested can immediately be tested in different flow conditions by moving it to different locations in the testing pipe.

Column 2, lines 40-50 of EBERT teach away from a narrowing or converging test pipe and disclose that sluiceway 33 is diverging to cause a slowing down of the velocity and turbulence to a steady flow which is necessary for proper operation of the tank. It appears that the flow basin of HUNZIKER is symmetrical such that HUNZIKER does not teach that the testing pipe decreases in diameter along a length of the testing pipe in a direction of fluid flow as recited in claim 34 of the present application.

Claims 35-40 depend from claim 34 and further define the invention and are also believed patentable over the cited prior art.

New independent claim 41 provides that the swimming device is closed to atmosphere except for an opening in the lure tower. As set forth above, the basin of EBERT is open. The test tank of HUNZIKER includes opening 40 for insertion of the marine engine 62 and also includes exhaust vent 33. Accordingly, the combination of references does not disclose or suggest a swimming device being closed to atmosphere except for an opening in the lure tower as recited in new claim 41 of the present application. Claims 42 and 43 depend from claim 41 and further define the

invention and are also believed patentable over the cited prior art.

By way of further explanation, an object of the present invention is to simply and quickly illustrate the functioning of a finished lure in different flow conditions. This object is met by having a simply constructed device of the present invention wherein in the first embodiment two pipes are interconnected by connectors and the flow is flown, for example, clockwise with the lure 12 in the flow. The testing pipe can be transparent to see how the lure acts in the water flow. In the embodiment of Figure 2, there is a substantially circular flow pipe 1 having flow ports 16, 17 at ends thereof and a testing pipe 2 fitting over the flow pipe and covering the flow ports. Once the device is filled with water, the lure can be placed into the testing pipe and the lure can be tested. The devices of the present invention are relatively small, portable and simple to construct.

As seen in Figures 5 and 6 of EBERT, the device of EBERT is very complicated including a plurality of exit grids 30 and a plurality of deflectors 57 bolted to shafts 58 by nuts 59. The device of EBERT would have to be drained for transport and is relatively complex to manufacture or assemble.

The device of HUNZIKER is a test tank for marine engines and is not related to the fishing lures at all. As seen in Figure 6 of HUNZIKER, a boat trailer is backed up to the tank

of HUNZIKER so that the engine 62 can be lowered into the tank for testing. The tank of HUNZIKER is a much larger scale than either the tank of the present invention or the tank of EBERT. Accordingly, one of ordinary skill in the art in the fishing lure testing art would not be motivated to use a marine engine testing tank as part of a rejection that renders obvious the claims of the present application.

Accordingly, it is believed that the new claims avoid the rejection under §103 and are allowable over the art of record.

In view of the present amendment and the foregoing remarks, it is believed that the present application has been placed in condition for allowance. Reconsideration and allowance are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

Respectfully submitted,

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